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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,329	02/17/2004	Jeff Grady	4185-101-CIP2	1103
23448 7590 07/03/2008 INTELLECTUAL PROPERTY / TECHNOLOGY LAW PO BOX 14329 RESEARCH TRIANGLE PARK, NC 27709				
EXAMINER VO, NGUYEN THANH				
ART UNIT 2618		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/780,329

Applicant(s)

GRADY, JEFF

Examiner

NGUYEN VO

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9-11,14-24,27 and 30-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9-11,14-24,27 and 30-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 9-11, 14-18, 22-24, 27, 30-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fadell (US 2004/0224638 A1, cited by applicant) in view of Qureshey (US 2002/0002039 A1, cited by examiner) and Tse Chun Hin (US 2005/0047071, cited by examiner).

As to claim 1, Fadell discloses an audio player assembly (see figures 2, 12) comprising (a) an MP3 player (see the MP3 player at paragraph [0043]); and (b) an audio player unit comprising at least one speaker (see figure 12), and a modular docking unit having a main body portion with a docking cavity therein for docking said MP3 player (see paragraphs [0007], [0074], [0081], [0088], [0091], [0096], [0107]), wherein said audio player unit is operatively connected with the MP3 player for receiving an audio signal produced by the MP3 player and for outputting a corresponding audible signal through the at least one speaker (see paragraphs [0007], [0074], [0081], [0088], [0091], [0096], [0107]). Fadell thus discloses all of the claimed limitations except (i) an FM receiver operatively coupleable with the speaker; and (ii) the modular docking unit further comprises any of a frequency indicator on the main body portion and a frequency tuning control on the main body portion.

With respect to the claimed limitation (i), Fadell does disclose at paragraph [0058] that the media devices 154 of figures 2 and 12 comprise audio equipment. Qureshey discloses an audio equipment (see “audio device system” at paragraphs [0018], [0020]) which comprise a FM radio receiver adapted to receive audio-containing radio signals transmitted from FM radio stations (see paragraphs [0011], [0080], [0088]). The FM radio receiver comprises a frequency indicator 1230 and a frequency tuning control (see paragraphs [0134]-[0137]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Qureshey to Fadell such that the audio equipment in figure 12 of Fadell comprises a FM radio receiver, in order to allow the users to enjoy FM audio signals broadcasted from FM radio stations (as suggested by Qureshey).

With respect to the claimed limitation (ii), Tse Chun Hin discloses an audio player assembly (see figure 3) having a modular docking unit 20 for docking a MP3 player 19, wherein the modular docking unit 20 comprises a frequency tuning control 23 on a main body portion (see paragraph [0026]; figure 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Tse Chun Hin to Fadell such that the frequency tuning control is located in the modular docking unit shown in figure 12 of Fadell, in order to allow the user to easily select the tuning frequency of the FM radio receiver, and to save spaces for other control buttons of the boom box.

As to claim 17, it is rejected for similar reasons as set forth in claim 1 above.

As to claims 3, 18, see Fadell, figures 4A-4B, 7E, 12-13.

As to claims 9, 22, 41, 48, see Fadell, paragraph [0074].

As to claims 10, 23, Fadell discloses fire-wire coupling as claimed (see paragraph [0004]).

As to claims 11, 24, 38, 49, the modified Fadell further discloses an amplifier 222 coupled with the speaker for outputting the amplified audio signal through the speaker as claimed (see Qureshey, figure 2).

As to claims 14, 27, see Fadell, figures 4A, 4B, 12.

As to claims 15, 30, 39, 50, see Fadell, paragraph [0043].

As to claims 16, 31, see Fadell, paragraph [0058].

As to claims 32, 34, 42, 44, the modified Fadell fails to disclose a digital frequency indicator as claimed (see Qureshey, figure 18B).

As to claims 33, 43, the modified Fadell discloses a frequency tuning control as claimed (see Qureshey, paragraphs [0134]-[0137]).

As to claims 35, 45, Fadell discloses a plurality of speakers as claimed (see figure 12).

As to claims 36, 46, Fadell discloses a battery 224 as claimed (see figure 5; paragraph [0074]).

As to claims 37, 47, Fadell discloses AC interface element as claimed (see figure 5; paragraph [0060]).

As to claims 40, 51, Fadell discloses USB coupling as claimed (see paragraphs [0004], [0074]).

3. Claims 4-5, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fadell in view of Qureshey and Tse Chun Hin, and further in view of Shealtiel (US 2002/0106993, cited by examiner).

As to claims 4-5, 19-20, the modified Fadell fails to disclose that the docking unit comprises at least one indicator light indicative of the operational state of the unit as claimed. Shealtiel discloses a docking unit 312 (see figures 6-7) comprising at least one indicator light indicative of the operational state of the unit (see paragraph [0076]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Shealtiel to the modified Fadell, in order to allow the user to visualize the operational state of the unit (as suggested by Shealtiel at paragraph [0076]).

4. Claims 6, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fadell in view of Qureshey and Tse Chun Hin and Shealtiel as applied to claims 4 and 19 above, and further in view of Dimenstein (US 2002/0086703, cited by examiner).

As to claims 6, 21, the modified Fadell fails to disclose that the indicator light indicates the charging status of a battery in the MP3 player docked in the docking cavity of the docking unit as claimed. Dimenstein discloses an indicator light 118 indicating the charging status of a battery in a communication device 109 docked in the docking cavity of a docking unit 100 (see paragraph [0035]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Dimenstein to the modified Fadell, in order to allow the user to visualize the charging state of the battery (as suggested by Dimenstein at paragraph [0035]).

5. Claims 52-60, 62-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fadell (US 2004/0224638 A1, cited by applicant) in view of Qureshey (US 2002/0002039 A1, cited by examiner).

As to claim 52, Fadell discloses an audio player (see figure 12; see also the boom box at paragraph [0058]) adapted for use with a portable digital media player having a storage medium adapted to receive and store digital media files (see the MP3 player at paragraph [0043]), the audio player comprising a main body portion having a docking cavity adapted to receive said portable digital media player (see figure 12), wherein the docking cavity includes therein an electrical coupling element adapted to engage the portable digital media player when the portable digital media player is received by the docking cavity (see paragraphs [0007], [0074], [0081], [0088], [0091], [0096], [0107]); and at least one speaker 376 (see figure 12) associated with the main body portion and selectively operable with the portable digital media player when received by the docking cavity, to output audible signals (see paragraphs [0007], [0074], [0081], [0088], [0091], [0096], [0107]). Fadell thus discloses all the claimed limitations except an FM receiver adapted to receive audio-containing radio signals from radio stations, and the FM receiver having an associated frequency indicator and a frequency tuning control disposed on the main body portion as claimed.

However, Fadell does disclose at paragraph [0058] that the media devices 154 of figures 2 and 12 comprise audio equipment. Qureshey discloses an audio equipment (see "audio device system" at paragraphs [0018], [0020]) which comprise a FM radio receiver adapted to receive audio-containing radio signals transmitted from FM radio

stations (see paragraphs [0011], [0080], [0088]). The FM radio receiver has a main body portion comprising a frequency indicator and a frequency tuning control (see figures 13A-13B; paragraphs [0134]-[0137]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Qureshey to Fadell such that the audio equipment in figure 12 of Fadell comprises a FM radio receiver, in order to allow the users to enjoy FM audio signals broadcasted from FM radio stations (as suggested by Qureshey).

As to claim 53, Fadell discloses the MP3 player at paragraph [0043].

As to claim 54, see Fadell, paragraphs [0007], [0074], [0081], [0088], [0091], [0096], [0107].

As to claims 55-57, 60, 64-65, see Fadell, paragraph [0074].

As to claim 58, the combination of Fadell and Qureshey discloses the claimed limitations (see Qureshey, figure 18B).

As to claim 59, the combination of Fadell and Qureshey discloses the claimed limitations (see Qureshey, figures 13A-13B, paragraphs [0134]-[0137]).

As to claim 62, see Fadell, paragraphs [0060], [0063], [0095].

As to claim 63, the combination of Fadell and Qureshey discloses an amplifier as claimed (see Qureshey, paragraph [0137]).

As to claim 66, Fadell discloses a plurality of speakers 376 (see figure 12).

As to claim 67, Fadell discloses a boom box as claimed (see paragraph [0058]).

As to claim 68, it is rejected for similar reasons as set forth in claim 52.

6. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fadell in view of Qureshey as applied to claim 52 above, and further in view of Dimenstein (US 2002/0086703, cited by examiner).

As to claim 61, the modified Fadell fails to disclose that the indicator light indicates the charging status of a battery in the MP3 player docked in the docking cavity of the docking unit as claimed. Dimenstein discloses an indicator light 118 indicating the charging status of a battery in a communication device 109 docked in the docking cavity of a docking unit 100 (see paragraph [0035]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Dimenstein to the modified Fadell, in order to allow the user to visualize the charging state of the battery (as suggested by Dimenstein at paragraph [0035]).

Response to Arguments

7. Applicant's arguments filed 04/18/2008 have been fully considered but they are not persuasive.

Independent claims 1, 17 and 52 are rejected over Fadell, Qureshey and Tse Chun Hin

Applicant argues that the combination of Fadell and Qureshey is improper because it is not obvious to provide the FM receiver in Qureshey to the audio player unit in figure 12 of Fadell. Applicant's reason is that numerous MP3 players have integrated FM receivers; therefore, the audio player unit in figure 12 of Fadell does not need an integrated FM receiver. See pages 16-17 of applicant's response. The examiner, however, disagrees. First of all, Qureshey is relied on for the teaching of an audio

player unit having an integrated FM receiver, not a MP3 player having an integrated FM receiver. Therefore, applicant's argument is moot. Second, incorporating the FM receiver in Qureshey to the audio player unit in figure 12 of Fadell (as taught by Qureshey) would be obvious because the user can enjoy FM audio signals from the audio player unit itself when the MP3 player is not used.

Applicant further argues that Qureshey has no need for a docking station adapted to receive a portable MP3 player to audibly reproduce audio files played by such device; therefore, one skilled in the art would not seek to modify a device according to Qureshey to include the docking station of Fadell. See page 18 of applicant's response. The examiner, however, disagrees. In response to applicant's argument that Qureshey is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Qureshey is in the field of applicant's endeavor, namely "an audio player assembly" (see Qureshey, paragraphs [0134]-[0137]).

Applicant further argues that Tse Chun Hin is directed to a car adapter device including an FM transmitter, not an FM receiver as recited in applicant's independent claims 1 and 17; therefore, Tse Chun Hin cannot be combined with Fadell and Qureshey. See page 18 of applicant's response. The examiner, however, disagrees. The fact that Tse Chun Hin discloses a car adapter device including a FM transmitter,

not a FM receiver, does not render the combination of Fadell, Qureshey and Tse Chun Hin improper. Since Tse Chun Hin discloses **a modular docking unit 20 for docking a MP3 player 19 as Fadell does**, one skilled in the art would seek to modify the docking unit in Fadell with the docking unit 20 in Tse Chun Hin such that the modular docking unit in Fadell comprises a frequency tuning control 23 on a main body portion (see Tse Chun Hin, paragraph [0026]; figure 3).

Secondary Consideration Evidence

Commercial Success

The commercial success provided by applicant is not found persuasive to overcome the finding of obviousness for the following reasons. Applicant fails to show that the commercial success directly derived from the invention claimed, "in a marketplace wherein the consumer is free to choose on the basis of objective principles" and it must be shown "that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention." MPEP 716.03(b). Accordingly, the applicant bears the burden of supporting the contention of nonobviousness by establishing a nexus between the claimed invention and evidence of commercial success. Also, the evidence provided must be commensurate in scope with the claims. Additionally, gross sales figures do not show commercial success absent evidence as to market share, or the time period during which the product was sold, or the normally expected sales in the market.

Applicant, on pages 19-22 of his response argues that the IBOOM boom box mentioned at paragraph 3 of the (First) Declaration of Jeff Grady filed on December 22, 2006 has a FM receiver, and a frequency indicator located in the modular docking unit as recited in claims 1 and 17. The examiner agrees with applicant.

In support of a nexus between the claimed invention and evidence of commercial success, applicant points out that numerous product reviewers and consumers have specifically identified the presence of an FM receiver in the IBOOM boom box as a critical feature supporting purchase of the product. See pages 23-28 of applicant's response. The examiner, however, disagrees. Applicant's argument on pages 23-28 does not show any evidence of commercial success of the IBOOM boom box, instead it just shows that there are **five** product reviewers and consumers who like the presence of an FM receiver in the IBOOM boom box.

Applicant further argues that Netalog sold more than 85,000 units of IBOOM boom box within two years, and that provides ample evidence of the "time period during which the product as sold". See pages 28-30 of applicant's response. The examiner, however, disagrees. The gross sales figures do not show commercial success absent evidence **as to what sales would normally be expected in the market**, *Ex parte Standish*, 10 USPQ2d 1454 (Bd.Pat. App. & Inter. 1988).

Applicant further argues that in *Ex parte Standish*, 10 USPQ2d 1454 (Bd.Pat. App. & Inter. 1988), the board suggests that it would have been helpful for the applicant to have provided evidence of normally expected sales, the Board did not go so far as to require such evidence to be presented to establish commercial success as an objective

or secondary consideration of non-obviousness of a claimed invention. See page 28 of applicant's response. The examiner, however, disagrees. The board clearly states that "The affidavit statement does **not** reflect the time period during which the lures were sold or **the average number of product sales per unit of time which would normally be expected in the market place under consideration**. Accordingly, **we cannot determine whether appellant's lure, in fact, has been commercially successful**". Therefore, the examiner contends that the gross sales figures do not show commercial success absent evidence **as to what sales would normally be expected in the market** according to *Ex parte Standish*, 10 USPQ2d 1454 (Bd.Pat. App. & Inter. 1988).

Applicant further argues that the IBOOM boom box had a 100% market share for products within the scope of the present patent claims at the time the IBOOM boom box was introduced because Mr. Grady was unaware of any other product embodying the features of the pending patent claims. See pages 29-30 of applicant's response. The examiner, however, disagrees. First of all, merely stating that Mr. Grady was unaware of any other product embodying the features of the pending patent claims is insufficient to demonstrate a 100% market share. Second, most of the nineteen (19) other products were also on the market within the past two years. It is not clear as to how the IBOOM boom box had a 100% market share within the past two years while most of the nineteen (19) other products were also on the market.

In addition, applicant fails to show that the commercial success directly derived from the invention claimed, "in a marketplace wherein the consumer is free to

choose on the basis of objective principles" and it must be shown "that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention."

Copying

Applicant's secondary evidence that the IBOOM boom box product was copied by others is not persuasive for following reasons. First of all, applicant admits that "Applicant has no direct evidence (e.g., testimony or other admissions) that third parties have copied Applicant's IBOOM boom box". Second, more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors such as a lack of concern for patent property or contempt for the patentees ability to enforce the patent. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). Evidence of copying was persuasive of nonobviousness when an alleged infringer tried for a substantial length of time to design a product or process similar to the claimed invention, but failed and then copied the claimed invention instead. *Dow Chem. Co. v. American Cyanamid Co.*, >816 F.2d 617<, 2 USPQ2d 1350 (Fed. Cir. 1987). Alleged copying is not persuasive of nonobviousness when the copy is not identical to the claimed product, and the other manufacturer had not expended great effort to develop its own solution. *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985).

Commercial Success by third parties

The examiner's comments in the "Commercial Success" section as set forth above are herein incorporated.

In addition, applicant admits that "While Applicant does not have access to sales figures or market share for such third party products", but argues that "the fact that so many products embodying the same features (i.e., features within the scope of the present patent claims) have been introduced very close in time to one another provides an irrefutable interference of substantially third party commercial success". See page 33 of applicant's response. The examiner, however, disagrees. The mere fact that so many products embodying the same features (i.e., features within the scope of the present patent claims) have been introduced very close in time to one another does NOT provide an irrefutable interference of substantially third party commercial success as alleged by applicant.

Dependent claims are rejected over the cited prior art

Applicant's is directed to the examiner's discussion of the rejection to independent claims 1, 17 and 52 over Fadell, Qureshey and Tse Chun Hin as set forth above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NGUYEN VO whose telephone number is (571)272-7901. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nguyen Vo/
Primary Examiner, Art Unit 2618
07/02/2008

